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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,026	03/21/2006	Colin John Davies	U 015679-6	8990
140	7590	02/09/2009		
LADAS & PARRY LLP 26 WEST 61ST STREET NEW YORK, NY 10023			EXAMINER HUYNH, SON P	
			ART UNIT 2424	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/529,026

Applicant(s)

DAVIES, COLIN JOHN

Examiner

SON P. HUYNH

Art Unit

2424

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 69-92 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 69-92 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 69-92 have been considered but are moot in view of the new ground(s) of rejection.

Claims 1-68 have been canceled.

Applicant argues the I frames in the present application comprising the embedded message, are the same I frames which are played out during trick mode. While Plotnick, by using different I frames in the ultimately displayed advertisement, teach away from the method and system disclosed in the present invention (page 7, paragraph 2). This argument is respectfully traversed.

the feature "I frames comprising the embedded message, are the same I frames which are played out during trick mode" is not recited in the claims. In addition, Plotnick discloses the alternative version of the advertisement may be a condensed version of the actual advertisement. Plotnick further discloses the I frame in the alternative version is the same as I frame in the actual version (for example I frame 1606 in original advertisement are the same I frame as in signal I frame repetition) - see include, but are not limited to, figures 16A-17, paragraphs 0059, 0063).

For reason given above, rejections on the claims are analyzed as discussed below.

Claim Rejections - 35 USC § 112

2. Claims 89-90 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 89-90 are indefinite because each of them is a single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph.- see M.P.E.P 2173.05 (II)). The feature "the method" in lines 1-2 of claim 89 is interpreted as best understood as --the system--, and "the method" in lines 1-2 of claim 90 is interpreted as best understood as --the apparatus--

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 69-92 are rejected under 35 U.S.C. 102(b) as being anticipated by Plotnick et al. (US 2002/0144262).

Note that all references incorporated by reference in their entirety in Plotnick are treated as part of the specification of Plotnick.

Regarding claim 69, Plotnick discloses a method for embedding a message in video stream, the method comprising:

- defining at least one key frame in the content (identify I frames - see include, but are not limited to, paragraphs 205-209);

- embedding the message in the at least one defined key frame (embedding/inserting a message including frame/information of alternative advertisement in at least one defined/flagged key frame - see include, but are not limited to, paragraphs 205-210);

- compressing at a video encoder the video content comprising the at least one defined key frame comprising the embedded message (e.g., MPEG encoder for compressing the video content into MPEG-2 format, wherein the MPEG-2 video content comprises the at least one defined/flagged key frame comprising the embedded message/information of alternative advertisement – see include, but are not limited to, paragraphs 0205-0210);

- wherein the message is visible only when the at least one defined key frame comprising the embedded message is playback using trick mode playback (information/frame of alternative ad is visible only when the at least defined/flagged key frame comprising message/frame information of alternative ad is playback using trick

play mode - figures 15-17, paragraphs 0094, 0101, 0183,0197, 0201, 0210, 0215, 0221-0224).

Regarding claim 70, Plotnick discloses the method as discussed in the rejection of claim 69. Plotnick further discloses the at least one key frame comprises a plurality of key frames (see key frames 1602, 1604, 1606, 1608, 1610 - figures 16a-16c).

Regarding claim 71, Plotnick discloses the method as discussed in the rejection of claim 70. Plotnick further discloses the embedding comprises embedding the message in each of the plurality of key frames (e.g., alternative advertisements 1620, 1640 – see include, but are not limited to, figures 16a-16c, paragraphs 210, 215).

Regarding claim 72, Plotnick discloses the method as discussed in the rejection of claim 70. Plotnick further discloses the embedding comprises embedding the message in only some of the plurality of key frames (e.g. alternative advertisements 1600, 1630, etc. figures 16a-16c).

Regarding claim 73, Plotnick discloses the method as discussed in the rejection of claim 69. Plotnick further discloses distributing a stream of compressed content onto a storage medium of an end user unit, the compressed content comprising a plurality of key frames, wherein each individual key frame comprises the embedded message (distributing MPEP stream for storing in storage of PVR/set top box, the content

comprises a plurality of I frames wherein each individual I frame comprises message/I frame for alternative advertisement - see include, but are not limited to, paragraphs 0122, 0125, 0126, 0128-0130, 0139, 0147, 0173-0174, 0210, 0215, figures 10-17).

Regarding claim 74, Plotnick discloses the method as discussed in the rejection of claim 73. Plotnick further discloses the storage medium comprises a removable storage medium (e.g., CD, DVD, standalone PVR, memory sticks, etc., paragraphs 0091, 0105, 0109).

Regarding claim 75, Plotnick discloses the method as discussed in the rejection of claim 73. Plotnick further discloses the storage medium is external to the end user unit (e.g., at the head end or standalone unit in other location external to the PVR – see include, but are not limited to, paragraphs 0064, 0097, 0105, 0121-0122, 0215, **0200**).

Regarding claim 76, Plotnick discloses the method as discussed in the rejection of claim 73. Plotnick further discloses the storage medium comprises a pre-recorded medium (e.g., VCR, PVR, DVD, etc. - see include, but are not limited to, paragraphs 0091, 0105, 0109, 0200, 0121-0122).

Regarding claim 77, Plotnick discloses the method as discussed in the rejection of claim 69. Plotnick further discloses the compressing comprises one of MPEG-2, and MPEG-4

compression (e.g. MPEG-2 or MPEG-4, see include, but are not limited to, paragraphs 0173, 0178, 0207).

Regarding claim 78, Plotnick discloses the method as discussed in the rejection of claim 77. Plotnick further discloses the key frame comprises an I-frame (figures 16a-16c, paragraphs 0205-0210).

Regarding claim 79, Plotnick discloses the method as discussed in the rejection of claim 69. Plotnick further discloses the embedded message comprises a text message (e.g., added text see include, but are not limited to, paragraphs 0094, 0129, 0136, 0142, **0215**).

Regarding claim 80, Plotnick discloses the method as discussed in the rejection of claim 69. Plotnick further discloses the embedded message comprises a graphic element (e.g., still image, or logo - see include, but are not limited to, figures 15-17, paragraphs 0059, 0060, 0063).

Regarding claim 81, Plotnick discloses a message delivery method comprising:

decompressing compressed video at a video decoder, the compressed video comprising a plurality of key frames (i.e. I frames) and non-key frames (i.e., B and P frames), at least one of the plurality of key frames comprising an embedded message

(see include, but are not limited to, paragraphs 109, 135-136 and embedded message is discussed in the rejection of claim 69);

selecting at least one of the plurality of key frames comprising an embedded message from the compressed content (selecting at least one of the I frames comprising embedded message/frame information of alternative advertisement in MPEG-2 content – see discussion in the rejection of claim 69 and figures 10-17, paragraphs 0109, 0135-0136, 210-212);

outputting, in trick mode playback, the selected at least one of the plurality of key frames comprising embedded messages, wherein the message is visible only when the selected at least one of the plurality of key frames is output in trick mode playback – see include, but are not limited to, figures 10-17 and discussion in the rejection of claim 69).

Regarding claim 82, Plotnick discloses the method as discussed in the rejection of claim 81. Plotnick further discloses the plurality of video frames is received from a broadcast video stream (see include, but are not limited to, paragraphs 0091-0092, 0107, figure 3).

Regarding claim 83, Plotnick discloses the method as discussed in the rejection of claim 81. Plotnick further discloses the plurality of video frames is received from a digital recording (e.g., DVD, PVR, see include, but are not limited to, paragraphs 0091, 0097, 0122, 0172-0174).

Regarding claim 84, Plotnick discloses the method as discussed in the rejection of claim 83. Plotnick further discloses the digital recording is pre-recorded on a medium (e.g., DVD, PVR, memory sticks, etc. – see paragraphs 0091, 0093, 0109, 0172-0174).

Regarding claims 85, 87-88, the additional limitations as claimed correspond to the additional limitations of claimed in claims 77, 79-80, and are analyzed as discussed in the rejection of claims 77, 79-80.

Regarding claim 86, Plotnick discloses the method as discussed in the rejection of claim 81. Plotnick discloses the plurality of key frames comprising an embedded message comprises a plurality of I frames (figures 16a-17).

Regarding claims 89-90, the limitations of the system and apparatus that correspond to the limitations of the method of claim 69 are analyzed as discussed in the rejection of claim 69.

Regarding claims 91-92, the limitations of the system and apparatus that correspond to the limitations of the method of claim 81 are analyzed as discussed in the rejection of claim 81

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Liga et al. (US 2003/0154128 A1) discloses communicating and displaying an advertisement using a personal video recorder.

Lennon (US 7,065,250 B1) discloses automated image interpretation and retrieval system.

Feinleib (US 6,637,032) discloses system and method of synchronizing enhancing content with a video program using closed captioning.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SON P. HUYNH whose telephone number is (571)272-7295. The examiner can normally be reached on 9:00 - 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S. Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Son P Huynh/
Primary Examiner, Art Unit 2424

February 2, 2009

